

REMARKS

Applicant respectfully requests reconsideration of this application, and reconsideration of the Office Action dated October 18, 2004 (Paper No. 5). Upon entry of this Amendment, claims 1-3 and 5 will remain pending in this application. The changes to claim 1 are supported by the specification and original claims. No new matter is incorporated by this Amendment.

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Claim 1 is rejected under 35 U.S.C. § 102(b) as purportedly anticipated by U.S. Pat. No. 5,881,214 to Morisawa et al. ((Morisawa '214). The Examiner maintains that Morisawa '214 teaches each feature of claim 1 and thus anticipates the claim. Applicant again respectfully traverses.

Independent claim 1 (from which claims 2, 3, and 5 all depend) concerns an image output apparatus. The apparatus is defined as including an index information storing section arranged to store an index registration table. The apparatus also is said to include an index registering circuit for registering, in response to image recognition by the index recognizing circuit, the index information recognized by the index recognizing circuit and corresponding storage area designation information for designating a storage area in the image storing section, associated with each other in the index registration table. The index registering circuit generates the storage area designation information upon recognition of the index information by the image recognizing circuit.

These features are neither taught nor fairly described by Morisawa '214. In the apparatus described by Morisawa '214, a disc ID code and an index image ID code have a one-to-one correspondence to a magnet optical disc memory. This correspondence is fixed before Morisawa '214's mark sheet is scanned, and the described barcodes are decoded. In contrast to Morisawa '214, in the claimed invention, the index registering circuit generates

storage area designation information when the index image recognizing circuit recognizes the index information. Accordingly, the index information and the corresponding storage area are not fixed until recognition of the index information occurs. Hence, Morisawa '214 in teaching preassigned correspondence between a disc ID code and an index image ID code, and an optical disc memory, can not teach or suggest Applicant's recited index information registering circuit that registers index information, and generates and registers storage area designation information at the time that the index recognizing circuit recognizes the index information. Morisawa '214 thus fails to teach or fairly describe each and every feature of claim 1 and thus cannot anticipate the claimed invention. Accordingly, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

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Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as purportedly obvious based on Morisawa '214 in view of U.S. Pat. No. 5,933,548 to Morisawa (Morisawa '548).

Claim 5 is rejected under 35 U.S.C. § 103(a) as purportedly obvious based on Morisawa '214 in view of Morisawa '548 and further in view of Machino et al. (JP 09-221263).

These two rejections are addressed together as similar issues apply to both. Moreover, Applicant respectfully traverses both rejections.

The deficiencies of Morisawa '214 are described above. Neither Morisawa '548 nor Machino remedy these deficiencies. None of the patents teaches or fairly suggests the index registering circuit features of the claimed invention. Moreover, there is nothing in the teachings of the cited art that would have motivated those of ordinary skill to employ the above described features of the claimed invention. Hence, these two rejections are also overcome and withdrawal of both is respectfully requested.

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Applicant respectfully submits that this Amendment and the above remarks obviate the outstanding rejections in this case, thereby placing the application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees are due in connection with the filing of this Amendment, such as fees under 37 C.F.R. §§1.16 or 1.17, please charge the fees to Deposit Account 02-4300; Order No. 032739.037.

Respectfully submitted,

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